

Attorney Docket No.:
017220.0115

REISSUE APPLICATION

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Tinker

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Greene, et al.

Patent No.:

5,203,267

Reissue Application No.:

08/425,766

Filing Date:

April 19, 1995

Title:

METHOD AND APPARATUS FOR
DISPOSING OF WASTE MATERIAL

Honorable Commissioner of
Patents and Trademarks
Washington, D.C. 20231

Dear Sir:

FAX COPY RECEIVED

DEC 16 1997

GROUP 3400

DUPPLICATE -
DO NOT ENTER
<DCJ 2/23/98>

JOINT REISSUE APPLICATION DECLARATION AND POWER OF ATTORNEY

We, Ralph F. Greene and Patrick C. Malone, hereby declare that:

1. Our residences, post office addresses, and citizenship are as stated below next to our names.
2. We have reviewed and understand the contents of the above identified specification, including the claims.
3. We believe that we are the original, first, and joint inventors of the subject matter which is described and claimed in United States Patent No. 5,203,267 ("the '267 Patent"), entitled "Method and Apparatus For Disposing of Waste Material," granted on April 20, 1993, and in the foregoing specification for which invention we solicit a reissue patent.
4. We acknowledge the duty to disclose information that is material to patentability as defined in 37 C.F.R. § 1.56.
5. We verily believe that the '267 Patent is partly inoperative by reason of our claiming less than we had the right to claim in the patent. The insufficiency of the claims is shown below.

6. We seek to broaden the scope of the independent claims in the reissue application. This request is filed within two years of the date of issue of the '267 Patent as required by 35 U.S.C. § 251.

7. Amendment of Claim 1. Claim 1 has been amended to remove the last element of the claim, which reads:

a liquid filter for capturing said particulate matter contained in said fired exhaust and for chemically treating said fired exhaust gases to reduce the quantity of CO, NO and SO contained in said fired exhaust.

(Hereinafter "the liquid filter element")

8. The liquid filter element in Claim 1 of the '267 Patent is not required to define a waste disposal apparatus that is patentable over the prior art. Claim 1, as amended, includes "a first combustion chamber for incinerating waste material in an oxygen rich atmosphere" and "a second combustion chamber for firing said exhaust . . . in an oxygen starved atmosphere." The references cited during prosecution of the '267 Patent and the references disclosed in the Information Disclosure Statement filed July 20, 1995 do not disclose, teach, or suggest the waste disposal apparatus recited in Claim 1, as amended. Prior art disposal systems use a first combustion chamber having an oxygen starved atmosphere and a second combustion chamber having an oxygen rich atmosphere that is the exact opposite of our novel waste disposal apparatus. Our invention of using an oxygen rich atmosphere in the first chamber allows for a rapid and more complete burn of the waste material than provided for in prior art systems.

9. During prosecution of the '267 Patent, the Examiner stated that the oxygen rich and deficient combustion stages of our then pending claims were well known in the art. We are not aware of any reference that discloses, teaches, or suggests the waste disposal apparatus recited in Claim 1, as amended, nor did the Examiner ever provide us with a reference to support this assertion.

10. During prosecution of the '267 Patent, we mistakenly believed that the liquid filter element, in combination with the first and second combustion chamber recited in Claim 1 of the

'267 Patent, was necessary to define over the prior art. We were mistaken in our belief because prior to our invention, it was not known to use an oxygen rich first combustion chamber and an oxygen starved second combustion chamber as recited in Claim 1, as amended. The liquid filter element that has been removed from Claim 1, as amended, is not required to define patentable subject matter.

11. This misunderstanding as to the scope of our invention was discovered at a meeting inventor Patrick C. Malone called with NCE executives and our patent counsel, Robert M. Chiaviello, Jr., on February 2, 1995, during which we reviewed the claims of the '267 Patent in connection with a possible infringement matter brought to our attention. In a review of those claims it was recognized that all of the claims had a limitation to a liquid filter. It was determined that, based on the original disclosure of our invention and Mr. Malone's personal understanding of the invention, a liquid filter was not necessary to practice the invention or define patentable subject matter. On that basis, it became clear to Mr. Malone that the claims of the '267 Patent were partially inoperative to the extent that they claimed less than we had a right to claim. This misunderstanding as to the scope of our invention arose without any deceptive intention on our part and arose because we failed to appreciate that Claim 1 of the '267 Patent did not embrace the full scope of our invention, as discussed above.

12. New Claim 19. New Claim 19 contains the subject matter of the liquid filter element of Claim 1 of the '267 Patent written in dependent form. No new matter has been added. New Claim 19 recites "The waste disposal apparatus of claim 1 further comprising a liquid filter for capturing said particulate matter contained in said fired exhaust and for chemically treating said fired exhaust gasses to reduce the quantity of CO, NO and SO contained in said fired exhaust."

As discussed above, the subject matter of new Claim 19 was removed from issued Claim 1 to allow Claim 1, as amended, to embrace the full scope of our invention. However, the subject matter removed from issued Claim 1 is an important feature of our invention being claimed, in this case in a dependent claim, to

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prevent the claims as a whole from being partially inoperative to the extent that they fail to claim subject matter for which we are entitled to patent protection. The misunderstanding as to the scope of our invention, making necessary the amendment of issued Claim 1 and the consequent need to include the subject matter removed from issued Claim 1 in new Claim 19, arose in the manner discussed above without any deceptive intention on our part and because we failed to appreciate that Claim 1 of the '267 Patent did not embrace the full scope of our invention.

13. Amendment to Claims 11, 12, 13, 14, and 18. Claims 11, 12, 13, and 18 are amended to depend from new Claim 19 rather than from Claim 1. Since the liquid filter element has been removed from Claim 1 and placed in new Claim 19, Claims 11, 12, 13, 14, and 18 are amended to maintain proper claim dependency. Amended Claims 11, 12, 13, 14, and 18 are therefore identical in scope to issued Claims 11, 12, 13, 14, and 18.

14. Amendment to Claim 15. Claim 15 has been amended to remove the last element in the claim which reads:

liquid filter means for capturing said particulate matter contained in said fired exhaust for chemically treating fired exhaust gases to reduce CO, NO, and HCL and SO₂ contained in said fired exhaust.

(Hereinafter the liquid filter means element.)

15. The amendment to issued Claim 15 is similar to the amendment to issued Claim 1 discussed above. The remaining elements in Claim 15 are patentable over the prior art as the prior art does not disclose a waste disposal system having an oxygen rich first combustion means and an oxygen poor second combustion means. During prosecution of the '267 Patent, we mistakenly believed that the liquid filter means element, in combination with the first and second combustion means recited in Claim 15, was required to define over the prior art. We were mistaken in our belief because prior to our invention, it was not known to use an oxygen rich first combustion means and an oxygen starved second combustion means as recited in issued Claim 15 and in Claim 15, as amended. The liquid filter means element recited in issued Claim 15 is not required to define patentable subject matter.

16. As discussed above, this misunderstanding as to the scope of our invention was discovered at a meeting inventor Patrick C. Malone called with NCE executives and our patent counsel, Robert M. Chiaviello, Jr., on February 2, 1995, during which we reviewed the claims of the '267 Patent in connection with a possible infringement matter brought to our attention. In a review of those claims it was recognized that all of the claims had a limitation to a liquid filter. It was determined that, based on the original disclosure of our invention and Mr. Malone's personal understanding of the invention, a liquid filter was not necessary to practice the invention or define patentable subject matter. On that basis, it became clear to Mr. Malone that the claims of the '267 Patent were partially inoperative to the extent that they claimed less than we had a right to claim. This misunderstanding as to the scope of our invention arose without any deceptive intention on our part and arose because we failed to appreciate that Claim 15 of the '267 Patent did not embrace the full scope of our invention.

17. New claim 20. New Claim 20 includes the subject matter of the liquid filter means element of Claim 15 of the '267 Patent written in dependent form. No new matter has been added. New Claim 20 recites "The waste disposal system of claim 15 further comprising a liquid filter means for capturing said particulate matter contained in said fired exhaust and for chemically treating said fired exhaust gasses to reduce CO, NO, HCL and SO₂ contained in said fired exhaust."

As discussed above, the subject matter of new Claim 20 was removed from issued Claim 15 to allow Claim 15, as amended, to embrace the full scope of our invention. However, the subject matter removed from issued Claim 15 is an important feature of our invention being claimed, in this case in a dependent claim, to prevent the claims as a whole from being partially inoperative to the extent that they fail to claim subject matter for which we are entitled to patent protection. The misunderstanding as to the scope of our invention, making necessary the amendment of issued Claim 15 and the consequent need to include the subject matter removed from issued Claim 15 in new Claim 20, arose in the manner discussed above without any deceptive intention on our

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part and because we failed to appreciate that Claim 15 of the '267 Patent did not embrace the full scope of our invention.

18. We hereby appoint, both jointly and severally, as our attorneys with full power of substitution and revocation, to prosecute this application and to transact all business in the Patent and Trademark Office connected herewith the following attorneys, their registration numbers being listed after their names:

| | |
|---------------------------|-----------------|
| Jerry W. Mills | Reg. No. 23,005 |
| Ann C. Livingston | Reg. No. 32,479 |
| William N. Hulsey III | Reg. No. 33,402 |
| Anthony E. Peterman | Reg. No. 38,270 |
| Robert M. Chiaviello, Jr. | Reg. No. 32,461 |
| Thomas R. Felger | Reg. No. 28,842 |
| Charles S. Fish | Reg. No. 35,870 |
| Robert H. Johnston III | Reg. No. 37,364 |
| Wei Wei Jeang | Reg. No. 33,305 |
| Christopher W. Kennerly | Reg. No. 40,675 |
| Kevin J. Meek | Reg. No. 33,738 |
| Barton E. Showalter | Reg. No. 38,302 |
| Terry J. Stalford | Reg. No. 39,522 |
| Daniel P. Stewart | Reg. No. 41,332 |
| David G. Wille | Reg. No. 38,363 |
| Bradley P. Williams | Reg. No. 40,227 |
| Philip W. Woo | Reg. No. 39,880 |
| Roger J. Fulghum | Reg. No. 39,678 |
| Rodger L. Tate | Reg. No. 27,399 |
| Scott F. Partridge | Reg. No. 28,142 |
| James B. Arpin | Reg. No. 33,470 |
| James Remenick | Reg. No. 36,902 |
| Jay B. Johnson | Reg. No. 38,193 |
| Christopher C. Campbell | Reg. No. 37,291 |
| Stacy B. Margolies | Reg. No. 39,760 |

19. All correspondence and telephone communications should be addressed to Baker & Botts, L.L.P., 2001 Ross Avenue, Dallas, Texas 75201-2980, telephone number (214) 953-6500, which is also the address and telephone number for each of the above-listed attorneys.

We hereby declare that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or

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imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that willful false statements may jeopardize the validity of the application or any patent issuing thereon.

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12-11-97
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By: Patrick C. Malone

on behalf of: Ralph M. Greene

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